

REMARKS

Applicants appreciate the time taken by Examiner Perez-Gutierrez to prepare the Office Action of June 1, 2004. Applicants further appreciate the time taken by Examiner Perez-Gutierrez to engage in a telephonic interview on August 18, 2004 – the substance of which is described in the Interview Summary mailed on August 25, 2004.

With respect to the outstanding § 102 and § 103 rejections of claims 1, 4, 8-10, 16, 18-20, 23, 26-29, and 31-39, Applicants respectfully traverse and submit that each of these claims is allowable.

To simplify the issues presented and to facilitate full allowance of the now pending claims, claims 11, 14, 16, 19, 26, 29, 31, 34, and 36 - 39 have been amended. Claims 1, 4, 8-10, 13, 28, and 30 have been cancelled without prejudice. These claims have been cancelled to advance the remaining claims to allowance and not for reasons related to patentability of the cancelled claims. Applicants intend to pursue protection for the subject matter of the cancelled claims in to-be-filed continuing applications.

No Claims have been added. No new subject matter has been added. Applicants respectfully request that the Examiner issue a Notice of Allowance for claims 11, 14-16, 18-21, 23, 26, 27, 29, 31, 32, and 34-39.

Drawing Objections

Figures 1, 6, and 8, are objected to under 37 CFR 1.83(a) and 1.84(p)(5). Replacement sheets including proposed corrections for Figures 1 and 6 are included herewith. Regarding the objection of Figure 8, Applicants respectfully request that the specification be amended as indicated herein. Applicants submit that the proposed corrections and amendments overcome the Drawing Objections and request that the objections be removed.

Claim Objections

Claim 19 is objected to for an informality related to proper antecedent basis. As mentioned above, claim 19 has been amended. Applicants submit that as amended Claim

19 is not objectionable and is fully allowable. Applicants respectfully request full allowance of Claim 19.

Claim Rejections – 35 U.S.C. § 112

Claim 14 is rejected under 35 U.S.C. § 112 as being indefinite. As mentioned above, claim 14 has been amended. Applicants submit that, as amended, Claim 14 is fully allowable. Applicants respectfully request full allowance of Claim 14.

Claim Rejections – 35 U.S.C. § 102

Claims 1, 4, 8-10, 16, 18-20, 23, 26-29, and 31-39 are rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,587,835 (Treyz, et al.). As mentioned above, claims 1, 4, 8-10, and 28, have been cancelled without prejudice. Claims 18-20, 23, 26 – 29 and 31 – 33, depend from independent claim 16, which has been amended. Claims 35 – 39 depend from independent claim 34, which has also been amended.

Applicants respectfully point out that independent claims 16 and 34, each include a limitation that is completely missing from Treyz, et al. **Both independent claims include a limitation related to altering the playing of an audio file in response to an incoming telephone call. The audio file in question existed at the telephonic device prior to receiving the incoming call – the file was not included with the incoming call.**

Treyz, et al. fails to disclose, teach, or suggest, altering or stopping the playing of a stored audio file in response to an incoming telephone call. In fact, Treyz, et al. fails to disclose doing anything in response to an incoming telephone call.

Treyz et al. does mention once, in passing, the ability to receive a telephone call – “handheld computing device 12 may be used to provide the user with an opportunity to send and receive e-mail, telephone calls, voice mail, paging messages, data service feeds, and any other suitable information or messages.” Col. 16, lines 60-63, but this disclosure in Treyz, et al. is unrelated to the currently pending claims. Applicants are attempting to claim a device that alters the playing of a stored audio file in response to an indication of incoming telephone call – Treyz et al. never mentions any such capability.

The Examiner has pointed out that Treyz, et al. does mention that "[i]f the user receives an incoming message, handheld computing device 12 may be used to present the message to the user at step 140." Col. 17, lines 5-7. Again, this disclosure in Treyz et al. misses the mark. Unlike the embodiment currently claimed, the shopping assistant of Treyz, et al. is merely receiving a message and presenting that same message to a user.

In their current forms, claim 16 recites a "processor module operable to **stop an in process playing of the audio file in response to receiving an indication of an incoming telephone call**" (emphasis added), and claim 34 recites "a processor module operable to **alter a playing of the selected audio information in association with an incoming telephonic communication**" (emphasis added). As mentioned above, Treyz, et al. fails to disclose doing anything in response to an incoming telephone call or stopping the playing of an audio file for any reason. For at least these reasons, Treyz, et al. cannot anticipate Claim 16, Claim 34, or the claims depending there from.

All of the currently pending claims relate to embodiments of Applicants' invention that facilitate storing an audio file (like an MP3 file) on a wirelessly enabled device and altering the playing of the file in response to an incoming telephone call. For example, a person may be storing an MP3 file on her cellular telephone, someone may call the telephone, and the telephone may begin playing the MP3 file. In practice, the person may hear the MP3 music start to play and know that someone is calling her cellular telephone. Similarly, the same person may be using her cellular telephone as an MP3 player. An incoming call signal may be recognized at the telephone, and the telephone may, for example, automatically reduce the volume of the MP3 music, stop the playing of the music, pause the playing (which may involve stopping the playing and restarting the playing at some later point in time), and/or otherwise alter the playing. In fact, in some cases, some of these capabilities may be combined. A device may be playing a first song. An incoming call signal may be received. The device may stop the playing of the first song and begin playing a different song.

Treyz, et al., does not relate in any way to these ideas. Treyz et al. describes a shopping assistant. Treyz et al. completely lacks any mention, teaching, disclosure, etc. of the above-discussed limitations. As such, Applicants submit that Treyz et al. cannot

anticipate any currently pending claim and that in light of the amendments to claims 16 and 34, Claims 16, 18-20, 23, 26, 27, 29, and 31-39 are fully allowable over Treyz et al. As such, Applicants respectfully request full allowance of Claims 16, 18-20, 23, 26, 27, 29, and 31-39.

Claim Rejections – 35 U.S.C. § 103

Claims 5-7 and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Treyz, et al. in view of allegedly well-known prior art. As mentioned above, Applicants respectfully traverse.

Claims 5-7 have been canceled without prejudice.

Claim 21 depends from claim 16, which has been amended to include a “processor module operable to **stop an in process playing of the audio file in response to receiving an indication of an incoming telephone call**” (emphasis added). As mentioned above, neither Treyz et al. nor the allegedly well-known prior art discloses, teaches, or even suggests, this limitation. Applicants submit that in light of the amendment to claim 16, claim 21 is fully allowable. As such, Applicants respectfully request full allowance of Claim 21.

Additionally, Applicants submit that any reliance on the disclosure of Treyz et al. in combination with a wide area wireless technology having always-on capabilities (such as GSM or CDMA) is improper. Treyz et al. actively teaches away from such a combination.

Treyz et al. discloses “a handheld computing device ... to provide a user with shopping assistance services.” See Treyz et al. Abstract. While Treyz et al. does mention cellular networks a handful of times in its more than 150 pages, when reference is made to cellular networks, the reference is largely derisive. In fact, Treyz et al. goes out of its way to suggest that cellular network resources are “too scarce to provide a practical [always-on] data communication link.” Col. 51, lines 1-10. According to Treyz et al., in an always-on configuration, considerations (like scarce wide-area resources) dictate using local communication links. See Id.

Claims 11, 13-15, and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Treyz, et al. in view of U.S. Patent No. 6,014,569 (Bottum). Applicants respectfully traverse the rejection. To expedite allowance of claims 11, 14, and 15, Claims 13 and 30 have been canceled without prejudice.

Like Treyz et al., Bottum completely lacks any mention of affecting the playing of an audio file in response to an incoming telephone call. Moreover, Bottum does not relate to devices that are capable of receiving telephone calls – let alone doing something in response to a telephone call.

Claims 14 and 15 depend from claim 11, which has been amended to include the limitation of **“a music file configured to be stored within a memory of an electronic device operable to play and pause the music file in response to an incoming cellular telephone call”** (emphasis added). As indicated above, neither Treyz et al. nor Bottum discloses, teaches, or even suggests, this limitation. As such, Applicants submit that Claims 11, 14, and 15, are fully allowable. Applicants respectfully request full allowance of Claims 11, 14, and 15.

Conclusion

Each of the independent claims, as amended, includes a limitation related to affecting the playing of an audio file in response to an incoming telephone call. The cited references fail to teach, disclose, or even suggest such a feature. In light of this failing in the art and for other reasons not discussed herein, Applicants submit that each of the currently pending independent claims is in condition for allowance.

Since each of independent claims 11, 16, and 34, is allowable, each of the dependent claims is likewise allowable over the relied upon references. Moreover, the dependent claims include additional features not discussed herein or found in the cited references.

Thus, for at least the foregoing reasons, Applicants respectfully submit that the present application is now in condition for allowance and reconsideration is respectfully requested. Accordingly, the Examiner is requested to issue a Notice of Allowance for all pending claims.

If, for any reason, the Office is unable to allow the Application on the next Office Action, and believes a telephone interview would be helpful, the Examiner is respectfully requested to contact the undersigned attorney or agent. Applicant(s) does not believe that any additional fees are due.

Sept 1st 2004
Date

Respectfully submitted,

[Signature]
Kevin R. Imes